

REMARKS

Claims 1-51 were pending as of the non-final Office Action mailed April 16, 2008. Claims 1-51 are being amended. Support for claim amendments can be found through the disclosure, for example, on pages 6-9. Claims 1, 18, and 35 are the independent claims. Reconsideration of the action and further examination are respectfully requested in light of the foregoing amendments and the following remarks.

Interview Summary

The Applicant thanks Examiner Brandenburg and Examiner Bayat for the courtesy of a telephonic interview on August 8, 2008. The time the Examiners spent with the applicant's representative Leila Abdi was greatly appreciated. During the interview, proposed claim amendments were discussed. Applicants described how the prior art cited in the Office Action does not include the claim limitations. The Examiners stated a new search would be conducted.

Specification Objections

The specification has been amended to recite the correct U.S. Patent Application No. on page 1, line 12, and element 100 has been amended on page 6, line 4. Withdrawal of the objections is respectfully requested.

Claim Objections

Claims 1-17 were objected to because claims 12-17 recite a "method" while claims 1-11 recite "a computer-implemented method." Claims 12-17 are being amended to recite "a computer-implemented method." Withdrawal of the claims objections is respectfully requested.

§ 112 Rejections

Claims 3, 16, 20, and 37 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 16 has been amended to recite “wherein the second electronic document comprises an electronic document that includes functionality to permit the user to purchase one or more items.” Therefore, withdrawal of the rejection is respectfully requested.

Claims 3, 20, and 27 recite a “morphing electronic advertisement,” not a morphing electronic document as the Examiner states. As recited in the specification on page 6, a “morphing advertisement may comprise an advertisement that changes from a first display format to at least one other display format (e.g., based upon a use request such as a user initiated activity, preference or movement). Claims 3, 20, and 27 are therefore not indefinite. Therefore, Applicant respectfully requests withdrawal of the rejection.

§ 102 and § 103 Rejections

Claims 1, 3-18, 20-35 and 37-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0032677 to Morgenthaler et al. (“Morgenthaler”). Claims 2, 19, and 36 are rejected under 36 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0032677 to Morgenthaler in view of U.S. Patent No. 7,058,593 to Merritt.

Independent claim 1 recites, *inter alia*, “receiving a first selection of an expansion icon associated with the electronic advertisement, where the expansion icon is selectable to transition the electronic advertisement from the first display format into a second display format; delivering the electronic advertisement in the second display format, the second display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option; receiving a selection of one of the one or more menu option; delivering a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement in the second display format.”

Morgenthaler does not disclose, teach or suggest all of the elements and limitations of the independent claim 1. Morgenthaler is directed to capturing static screen shot images of website homepages, converting them into compressible files and constructing and categorizing these

screen shots into a relational database, which allow search queries to display the screen shots in various sizes within a slideshow format or business directory format. *See Abstract.* The system permits a user to conduct graphically conduct Internet searches, called Website Slide Show Technology (WSST). *See paragraph 0094.* WSST gathers Internet information retrieved based on the user's preferences or specific search query and presents the information in a graphical format, wherein frozen images, or screen shots of query matching website homepages will be displayed to Internet users. *See id.* WSST allows Internet users to review a website's content prior to actually linking directly to the website. *See id.*

As described by Morgenthaler with respect to FIG. 7, an end user accesses "room102.com" to conduct an internet query, and will be provided with an option to conduct a categorical or sub categorical search. *See paragraph 0145.* Regardless of whether the end user conducts a categorical search or a term search, the system will present a screen as depicted in FIG. 7. *See id.* End users have four options on the manner in which the WSST will be displayed, depending on the end user's Internet connection speed. *See id.* End users have available a full sized, high and low bandwidth Slideshow, thumbnail results with text, and a text-only search format. *See id.* Based on an end user's selection of manner to view a graphical search query, the user will then be able to view query matching results in a slide show format. *See id.*

Morgenthaler does not present any electronic advertisements. Moregenthaler merely presents a slideshow of query matching results in response to a query, and allows a user to select the format to view the results. *See [0145].* In fact, the only mention of advertisements in Morgenthaler is with respect to FIG. 15. Morgenthaler states that "FIG. 15 demonstrates the manner in which the current invention's preferred embodiment allows for advertising revenue generation from the variable display within the slideshow itself." *See paragraph 0155.* Immediately following an Internet search query using the Morgenthaler system, a list of relevant captured screen shot images is returned for display in a designated order in the slideshow. *See id.* Morgenthaler allows for interested commercial entities to purchase an advertisement slide or slot to be placed within the sequence of queued slides in the slideshow. *See id.*

The advertisements placed within the sequence of queried slides in the slideshow in Morgenthaler are not disclosed or taught to be associated with “an expansion icon used to transition the electronic advertisement from the first display format into a second display format,” as recited in claim 1. Nor are the advertisements mentioned with respect to FIG. 15 of Morgenthaler delivered “in the second display format, the second display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option. Morgenthaler also does not disclose or teach “receiving a selection of one of the one or more menu options; and delivering a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement in the second display format,” as recited in claims 1, 18, and 35. Morgenthaler merely mentions being able to include advertisements within the slideshow of query related search results displayed in FIG. 7, but does not disclose any specifics about the advertisements.

Accordingly, Morgenthaler does not disclose, teach or even suggest all of the elements and limitations of the independent claims 1, 18, and 35 of the instant case. The Applicant, therefore, respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(e) rejection of independent claims 1, 3-18, 20-35, and 37-51, as well as all dependent claims.

The features addressed in reference to claims 1, 18, and 35 are found in claims 2, 19, and 36 and, as explained above, not found in Morgenthaler. The Examiner cites Merrit only for its teaching of a home menu option. (Office Action, p. 16.) However, Merrit does not teach or suggest the claimed subject matter missing from Morgenthaler, namely, “receiving a search query from a second member of the social network, wherein the sale item is responsive to the search query . . . and outputting at least a portion of the sale information to the second member only if the audience criterion is satisfied by the second member, and making no portion of the sale information available to the second member if the audience criterion is not satisfied by the second member.”

Accordingly, Morgenthaler and Merrit taken alone or in combination, do not teach or suggest each and every element of claims 2, 19, and 36 and, therefore, cannot support a rejection

of these claims under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons.

### **Conclusion**

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 8/18/2008

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